

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed December 1, 2005. Claims 1-7 and 13-19 were pending in the Application. In the Office Action, Claims 1-7, 13, 14 and 17-19 were rejected, and Claims 15 and 16 were objected to. In order to expedite prosecution of this Application, Applicants amend Claim 1 and add new Claims 20-24. Thus, Claims 1-7 and 13-24 remain pending in the Application. Applicants respectfully request reconsideration and favorable action in this case.

In the Office Action, the following actions were taken or matters were raised:

SECTION 102 REJECTIONS

Claims 1, 2, 3 and 5-7 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,714,324 issued to Kurosawa et al. (hereinafter “*Kurosawa*”). Applicants respectfully traverse this rejection.

Of the rejected claims, Claim 1 is independent. Applicants respectfully submit that *Kurosawa* does not disclose or even suggest each and every limitation of amended independent Claim 1. For example, Applicants respectfully submit that *Kurosawa* does not disclose or even suggest “a template body . . . [having] an element disposed [thereon] for generating an optical pattern when scanned in [a] scanner system, the optical pattern indicating at least one of a reflective scan routine and a transparent scan routine for scanning the media object” (emphasis added). *Kurosawa* appears to be directed toward a film scanner for scanning images formed on a film (*Kurosawa*, abstract). *Kurosawa* also appears to disclose film holders 201a and 201b each having a bar code disposed thereon for identifying the film strip to be scanned (*Kurosawa*, column 7, lines 29-56). Thus, *Kurosawa* does not appear to disclose or even suggest a template having an element for generating an optical pattern where the optical pattern is used to indicate at least one of a reflective scan routine and a transparent scan routine for scanning the media object as generally recited by amended Claim 1. To the contrary, *Kurosawa* appears to be limited to transmissive scanning using a diffused light source 111 (*Kurosawa*, column 3, line 50 to column

4, line 4). Therefore, for at least this reason, Applicants respectfully submit that *Kurosawa* does not anticipate amended Claim 1.

Claims 2, 3 and 5-7 that depend from independent Claim 1 are also not anticipated by *Kurosawa* at least because they incorporate the limitations of Claim 1 and also add additional elements that further distinguish *Kurosawa*. Therefore, Applicants respectfully request that the rejection of Claims 2, 3 and 5-7 be withdrawn.

SECTION 103 REJECTIONS

Claims 4 and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Kurosawa*. Claims 13, 14, 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,850,344 issued to Chang (hereinafter “*Chang*”) in view of *Kurosawa*. Applicants respectfully traverse these rejections.

Claim 4 depends from independent Claim 1. At least for the reasons discussed above, independent Claim 1 is patentable over *Kurosawa*. Therefore, Claim 1 that depends from independent Claim 1 is also patentable. Accordingly, Applicants respectfully request that the rejection of Claim 4 be withdrawn.

Of the remaining rejected claims, Claim 13 is independent. In the Office Action, the Examiner appears to assert that *Chang* discloses “a template comprising an element for generating an optical pattern when scanned in the scanner system (figs. 1 and 2, col. 3, lines 41-58)” (Office action, page 4). In the Office Action, the Examiner does not explicitly identify what elements of the *Chang* reference the Examiner considers to correspond to the various elements recited by Claim 13. For example, the Examiner fails to explicitly identify what elements of the *Chang* reference the Examiner considers to correspond to the “transparent media adapter,” the “template” and the “element for generating an optical pattern” recited by Claim 13 making it difficult, if not impossible, for Applicants to fairly address the Examiner’s rejection of Claim 13. Applicants respectfully request that if the Examiner maintains the rejection, the Examiner make

any subsequent office action non-final and explicitly identify what elements of the *Chang* reference the Examiner is relying on to reject the claims of the present Application to provide Applicants with a fair opportunity to address any such rejection.

Notwithstanding the above, in the Office Action, the Examiner refers to a template comprising an element for generating an optical pattern when scanned in the scanning system of *Chang* (Office Action, page 4). The Examiner is apparently referring to the optical recognition mark 122 disposed on box 12 of *Chang* (*Chang*, paragraph 0026). Applicants respectfully disagree. *Chang* appears to disclose a scanning apparatus having a transparency adapter 11, a box 12, and a plurality of frames 14 (*Chang*, paragraph 0024). *Chang* also appears to disclose that the transparency adapter 11 of *Chang* is attached to a cover 22 of the scanner apparatus of *Chang* and has a window 112 and a light emitting element 111 for emitting light to the article to be scanned through the window 112 (*Chang*, paragraph 0024). The frames 14 of *Chang* appear to be used for fixing or holding an article to be scanned (*Chang*, paragraphs 0024 and 0028, figure 3). Applicant respectfully points out to the Examiner that the box 12 of *Chang* is used to store the frames 14 of *Chang* apparently when the frames 14 of *Chang* are not in use (“When frames 14a, 14b, and 14c for fixing articles are not used, it is possible to place them into box 12. Then secure frames [14] . . . and box 12 to cover 22. This is a preferred form of storing frames [14]” (*Chang*, paragraph 0028)). In fact, *Chang* discloses that “box 12 in an opaque member being releasable secured to transparency adapter 11 [on cover 22]” where “[w]indow 112 is entirely covered when box 12 is secured to transparency adapter 11” (*Chang*, paragraph 0024). Thus, the box 12 of *Chang* is apparently not used to hold or support objects or articles to be scanned but, in contrast, is only used to store the frames 14 of *Chang* when the frames 14 of *Chang* are not in use. Therefore, the box 12 with recognition mark 122 of *Chang* is not “a template adapted to receive a media for scanning [having] an element for generating an optical pattern when scanned” as recited by Claim 13. Therefore, for at least this reason, Applicants respectfully submit that Claim 13 is patentable over the cited references.

Further, Applicants respectfully submit that there is no motivation or suggestion to combine reference teachings as proposed by the Examiner. For example, in the Office Action, the Examiner states that “*Kurosawa* discloses a template adapted to receive a media for scanning” and that “it would have been obvious . . . to combine *Chang*’s invention with that of *Kurosawa* to have the media for scanning secured in the template” (Office Action, pages 4 and 5). Applicants respectfully disagree. As discussed above, *Chang* discloses frames 14a, 14b and 14c for holding various types of media objects during scanning thereof (*Chang*, column 4, lines 21-45). Thus, there is no motivation or suggestion to include the template of *Kurosawa* in the *Chang* system for receiving a media object at least because *Chang* already has such a device for receiving media objects, namely, the frames 14a, 14b and 14c of *Chang*. Accordingly, for at least this reason also, Applicants respectfully submit that Claim 13 is patentable over the cited references.

Claims 14 and 17-19 depend from independent Claim 13. As discussed above, Claim 13 is patentable over the cited references. Therefore, Claims 14 and 17-19 that depend therefrom are also patentable. Accordingly, Applicants respectfully request that the rejection of Claims 13, 14 and 17-19 be withdrawn.

CLAIM OBJECTIONS

The Examiner objected to Claims 15 and 16 as being dependent on a rejected base claim (Claim 13). Applicants thanks the Examiner for indicating that Claims 15 and 16 would be allowable if rewritten in independent form. However, as discussed above, independent Claim 13 is patentable over the cited references. Therefore, Claims 15 and 16 which depend from independent Claim 13 is also patentable. Thus, Applicants respectfully request that this objection be withdrawn.

NEW CLAIMS

Applicants add new Claims 20-24. New Claims 21-24 depend from new independent Claim 20. Applicants respectfully submit that new Claims 20-24 are patentable over the cited art of record. Therefore, Applicants respectfully request allowance of new Claims 20-24.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

No fee is believed due with this Response. If, however, Applicants have overlooked the need for any fee due with this Response, the Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this Response to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,

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